

Atty. Dkt. No. 10012668-1

REMARKS

This Reply is in response to the Office Action mailed on December 15, 2005.

Applicant requests reconsideration and allowance of the present application in view of the following.

I. Claim Rejections

Claims 1, 9-13, 21, 22, and 25-31 stand rejected as anticipated by Tanimoto (U.S. Patent No. 6,952,280). Applicant respectfully traverses these rejections.

Applicant submits that claim 1 is not anticipated by Tanimoto because Tanimoto does not disclose a "priority media device configured to selectively block media in the priority feed tray" as recited in claim 1.

Tanimoto, referring to FIG. 3, discloses using "the plurality of paper supply means to print out onto a variety of different types of papers of different sizes onto a variety of different types of paper, including papers of different sizes, proportions, or material characteristics." (Col. 4, Lines 14-17). Tanimoto does not, however, explicitly disclose any feature "configured to selectively block media in the priority feed tray" as recited in claim 1.

The Office Action does not meet the burden of establishing that Tanimoto inherently discloses a "priority media device configured to selectively block media in the priority feed tray" as recited in claim 1. Indeed, in "relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (emphasis in original). (MPEP 2112 (IV)). Here, the Office Action fails to provide any basis in fact or technical reasoning to reasonably support the determination that Tanimoto inherently teaches a "priority media device configured to selectively block media in the priority feed tray" as recited in claim 1.

Additionally, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. (see

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MPEP 2112 (IV). Applicant submits that the disclosed Tanimoto function of using "the plurality of paper supply means to print out onto a variety of different types of papers of different sizes onto a variety of different types of paper, including papers of different sizes, proportions, or material characteristics" could be accomplished by structures other than a "priority media device configured to selectively block media in the priority feed tray." As such, Tanimoto does not inherently or expressly anticipate claim 1. Withdrawal of this rejection is requested.

Claim 9 is amended to recite "a priority media release device movable between a media blocking position and a media admitting position under control of the processor." Applicant submits that no such media release device is disclosed by Tanimoto. As such, Applicant submits that Tanimoto does not anticipate claim 9. Withdrawal of the rejection of claim 9 is requested.

Claims 10-13 depend upon claim 9 and are allowable for at least the same reasons claim 9 is allowable. Withdrawal of these rejections is requested. Claims 21 and 22 are cancelled, thus rendering moot the rejections thereof.

Claim 25 is amended to recite "wherein the releasing comprises moving a member from a blocking position to a non-blocking position." Applicant submits that Tanimoto does not disclose releasing by "moving a member from a blocking position to a non-blocking position" and, as such, does not anticipate claim 25 as amended. Withdrawal of this rejection is requested.

Claims 26-28 depend upon claim 25 and are allowable for at least the same reasons as claim 25 is allowable. Withdrawal of this rejection is requested. Claims 29-32 are cancelled, thus rendering moot the rejections thereof.

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II. Claim Objections

Claims 2-7 were objected to as being dependent upon a rejected base claim. Claim 2 is rewritten in independent form. Claims 3-7 depend upon claim 2. As such, the objections to these claims are overcome. Withdrawal of these objections is requested. Claim 8 depends upon claim 1. Applicant submits that claim 1 is allowable for at least the reasons discussed above. Accordingly, Applicant requests withdrawal of the objection to claim 8. Claim 23 is rewritten in independent form, thus overcoming the objection thereto. Claim 24 depends upon claim 23. Accordingly, Applicant submits that the objections to claims 23 and 24 are overcome.

III. Conclusion

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

Date

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